

**This Opinion is Not a
Precedent of the TTAB**

Mailed: June 2, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Hana Financial Group Inc.
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Serial No. 86019890
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Michelle L. Wisniewski and Carlo F. Van den Bosch of
Sheppard Mullin Richter & Hampton LLP,
for Hana Financial Group Inc.

Brian Pino, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Kuhlke, Lykos and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Hana Financial Group Inc. (“Applicant”) seeks registration on the Principal
Register of the mark



(the “HANA BANCORP and Design” mark – “Bancorp” disclaimed) for:

Advertising; business management; business administration; office
functions, in International Class 35; and

Insurance, namely, insurance underwriting, insurance brokerage, insurance administration, insurance consultation, insurance claims administration; Financial affairs and monetary affairs, namely, financial advisory and consultancy services, providing financial information, management and analysis services; Monetary affairs, namely banking; Real estate affairs, namely, real estate agencies, real estate appraisal, real estate brokerage, real estate consultancy, real estate financing services, in International Class 36.¹

The Trademark Examining Attorney refused registration of Applicant's HANA BANCORP & Design mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the services identified in the registration, so resembles the registered mark



Hana Financial

(the “HANA FINANCIAL and Design” mark – “Financial” disclaimed) for:

Financial services, namely factoring services, asset-based lending, equipment lease financing, international trade financing, real estate financing, and investment consulting services, in International Class 36.²

¹ Application Serial No. 86019890 was filed on July 25, 2013, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). The mark is described in the application as follows: “Color is not claimed as a feature of the mark. The mark consists of the stylized wording ‘HANA BANCORP’ and the stylized design of a person.”

² Registration No. 1987227 was issued on July 16, 1996; renewed. The mark is described in the registration as follows: “The mark consists of a 3-Dimensional triangle with a stylized comet crossing from right to left in the middle of the triangle with the words HANA FINANCIAL appearing beneath the drawing.” The last listed owner of this registration in the USPTO's records is Hana Commercial Finance, Inc., a Delaware corporation.

as to be likely to cause confusion, mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

I. The Examining Attorney’s Evidentiary Objections

Before proceeding to the merits of the refusal, we address evidentiary issues the Examining Attorney raised in his brief.

A. KEB HANA BANK and Design Registrations

The Examining Attorney objects to Applicant’s introduction of the following service mark registrations:

Reg. No. 6061371 ( KEB Hana Bank), and
Reg. No. 6061372 ( KEB 하나은행)

and any arguments based on these registrations. The USPTO issued both registrations to Applicant’s affiliate, KEB Hana Bank, on May 26, 2020. The Examining Attorney objects to the Board’s consideration of these registrations on the ground that Applicant did not make them of record during the prosecution of HANA BANCORP & Design application.³ Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002) (refusing to consider

³ Examining Attorney’s Brief, 12 TTABVUE 4. Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

Applicant's evidence because "Applicant did not comply with the established rule that the evidentiary record in an application must be complete prior to the filing of the notice of appeal.").

Applicant responds that it placed both marks into evidence with its Request for Reconsideration filed on March 20, 2020. On that date, the underlying applications for these marks had been published for potential opposition but had not yet registered. In its Request for Reconsideration, Applicant referenced both marks by serial number and submitted copies of their publication notices.⁴ Registrations for those marks then issued on May 26, 2020. Thus, says Applicant, they were not new to the record with Applicant's appeal brief, but were made part of the record on March 20, 2020.⁵

Although technically untimely, we consider these registrations because the Examining Attorney did not advise Applicant, when the notices of publication were originally submitted during the prosecution of the application, of their limited probative value, or that copies of the registrations were necessary. *See In re Hayes*, 62 U.S.P.Q.2d 1443, 1445 n.3 (TTAB 2002) (registrations considered part of appellate record where copies of Official Gazettes showing they had been published for opposition were submitted as evidence during prosecution). The Examining Attorney's objection therefore is **overruled**.

⁴ Request for Reconsideration of March 20, 2020 at TSDR 9-10, 28-30.

⁵ Applicant's Rebuttal Brief, 13 TTABVUE 2-3.

B. List of Third-Party Registrations from TESS Database

The Examining Attorney also objects to Applicant's submission of a list from the USPTO's TESS database of 1,059 live third-party registrations issued in International Class 36 for service marks including the terms "one" or "first."⁶ Applicant submitted this list of third-party registrations to show that the term "HANA," which Applicant says is Korean for "one" or "first," is weak because it exists within a crowded marketplace of such marks for financial services incorporating such terms.⁷

Third-party registrations may not be made of record by merely listing them in response to an Office Action. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (June 2020) and cases cited therein. The proper way to submit third-party applications and registrations into the record is to submit a copy of the applications or registrations themselves, or the electronic equivalent thereof from the USPTO's electronic databases. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006) ("[T]he mere submission of a listing from the TESS database is insufficient to make the referenced registrations of record. To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted."). The Examining Attorney's objection to Applicant's submitted list from

⁶ Request for Reconsideration of March 20, 2020 at TSDR 31-63.

⁷ Applicant's Brief, 9 TTABVUE 15-17.

the USPTO's TESS database of third-party "one" and "first" registrations therefore is **sustained**.

II. Likelihood of Confusion - Applicable Law

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") (cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, "each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

Varying weights may be assigned to the various *DuPont* factors depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("the various evidentiary factors may play more or less weighty roles in any particular determination"). In fact, "any one *DuPont* factor may be dispositive in a particular case" *See Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (dissimilarity of the marks found dispositive) (citing *Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 21 USPQ2d 1142, 1144-45 (Fed.Cir.1991)).

III. Likelihood of Confusion - Analysis of the Controlling Thirteenth *DuPont* Factor

The likelihood of confusion factors Applicant discussed are the strength of the cited mark, the dissimilarity of the respective marks, the sophistication of the consumers for the services, the co-existence of the respective marks without evidence of actual confusion, and Applicant's claimed ownership of prior registrations for similar marks. The factors the Examining Attorney discussed are the similarity of the respective marks and their associated services, including the channels of trade and classes of purchasers therefor. The Examining Attorney also addressed Applicant's arguments.

As we find below, the thirteenth *DuPont* factor, ownership of prior registrations for similar marks that are not materially different from Applicant's pending mark, outweighs the other *DuPont* factors that otherwise would support findings that confusion is likely; that is, the strength of Registrant's mark, the similarity of Applicant's and Registrant's marks, the similarity of the respective services and overlapping channels of trade.

The thirteenth *DuPont* factor considers "any other established fact probative of the effect of use." *DuPont*, 177 USPQ at 567. Applicant argues that its pending HANA BANCORP and Design mark is nearly identical to the marks shown in four federal registrations it also claims to own, as follows:

Mark	Reg. No./Reg. Date	Services	Owner
	Reg. No.: 4861400 Reg. Date: Dec. 1, 2015	Banking, Cl. 36	Hana Bank
	Reg. No.: 5519744 Reg. Date: Jul. 17, 2018	Business management; business management planning; business management supervision, Cl. 35	Hana Bank
	Reg. No.: 6061371 Reg. Date: May 26, 2020	Insurance, namely, life insurance underwriting; financial affairs, namely, financial advisory services relating to asset management; monetary affairs, namely, banking; loan financing, Cl. 36	KEB Hana Bank
 The non-Latin characters in the mark transliterate to “HANA EUNHAENG” and this means “HANA BANK” in English.	Reg. No.: 6061372 Reg. Date: May 26, 2020	Insurance, namely, life insurance underwriting; financial affairs, namely, financial advisory services relating to asset management; monetary affairs, namely, banking; loan financing, Cl. 36	KEB Hana Bank

The details of Applicant’s pending application are:

Mark	App. No./ Filing Date	Services	Owner
	App. No.: 86019890 Filing Date: Jul. 25, 2013	Advertising; business management; business administration; office functions, Cl. 35 Insurance, namely, insurance underwriting, insurance brokerage, insurance administration, insurance consultation, insurance claims administration; Financial affairs and monetary affairs, namely, financial advisory and consultancy services, providing financial information, management and analysis services; Monetary affairs, namely banking; Real estate affairs, namely, real estate agencies, real estate appraisal, real estate brokerage, real estate	Hana Financial Group Inc.

Mark	App. No./ Filing Date	Services	Owner
		consultancy, real estate financing services, Cl. 36	

Applicant contends that the Examining Attorney erred by denying registration of the mark of its pending application under the “rule of consistency in examination,” particularly in light of his failure to identify any resulting harm from doing so.⁸ The Examining Attorney argues the issuance of registrations for prior marks having characteristics similar to Applicant’s pending mark should be considered under the analysis set forth in *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399-1400 (TTAB 2012),⁹ which we discuss below.

Before we address the prior registrations under the thirteenth *DuPont* factor, we note that Applicant’s claim of ownership of Registration Nos. 4861400, 5519744, 6061371 and 6061372 pertains to prior registrations owned by its wholly-owned subsidiaries. Registration Nos. 4861400 and 5519744 were issued in the name of Hana Bank. In a declaration submitted pursuant to Trademark Rule 2.20, 37 C.F.R. § 2.20, Applicant’s Manager, Ms. Do Kyung Kim, attests that Hana Bank is Applicant’s wholly-owned subsidiary.¹⁰ Given that Registration Nos. 4861400 and 5519744 are owned by Applicant’s wholly-owned subsidiary, Applicant may rely on them for purposes of asserting no likely confusion under this *DuPont* factor.

⁸ Applicant’s Brief, 9 TTABVUE 12-14; Applicant’s Reply Brief, 13 TTABVUE 4-6.

⁹ Examining Attorney’s Brief, 12 TTABVUE 13.

¹⁰ Declaration of Ownership, Office Action Response of March 11, 2019 at TSDR 9. Because we do not rely on Registration Nos. 6061371 or 6061372 in support of our decision, we do not address their ownership.

As discussed in *In re Strategic Partners*, the factors to be considered in determining the significance of a prior registration owned by an applicant under the thirteenth *DuPont* factor include:

- There is no “meaningful difference” between the marks in applicant’s prior registration and its present application – that is, there is no material difference between the marks;
- The services are at least in-part identical; and
- Both the applicant’s prior registration and the cited registration are more than five years old and thus immune from attack on likelihood of confusion grounds.

In re Strategic Partners, 102 USPQ2d at 1399. The Board acknowledged these facts constituted a “unique situation,” such that an applicant’s prior registration would generally need to fit within these parameters to overcome a Section 2(d) refusal. *Id.* at 1400.

The facts of *In re Strategic Partners* are illustrative. There, the Board found no likelihood of confusion between applicant’s applied-for mark ANYWEAR for “footwear” and the cited registration ¹¹ for “jackets, shirts, pants, stretch T-tops and stoles.” The Board noted that the applicant’s prior registration for the mark ANYWEARS (in standard characters) for, inter alia, “footwear” had coexisted with the cited registration for over five years, and the applicant’s existing registration was not subject to attack by the owner of the cited registration on a claim of priority and likelihood of confusion. These facts tipped the scale in favor of the applicant and a

¹¹ The literal portion of the mark reads: ANYWHERE BY JOSIE NATORI.

finding of no likelihood of confusion.” *In re Strategic Partners*, 102 USPQ2d at 1399-1400.

Registration No. 4861400 for the mark HANA BANK and Design, issued in December 2015 for “banking” services. Registration No. 5519744 for the mark HANA GROUP and Design, issued in July 2018 for “business management; business management planning; [and] business management supervision” services. We address each registration in turn.

We find there is no “meaningful difference” between the prior HANA BANK and Design mark and Applicant’s pending HANA BANCORP and Design mark. Both marks begin with the term HANA and contain the same design element. “The marks’ second terms vary only slightly. “The ... [pending mark’s] second term, BANCORP, alters BANK only by changing the ‘C’ to a ‘K’ and adding the three letters ‘ORP.’”¹² The Class 36 services in the prior HANA BANK and Design registration and the pending HANA BANCORP and Design application are identical or otherwise related. Both the HANA BANK and Design registration and the cited HANA FINANCIAL and Design registration have been extant for over five years.

We also find there is no “meaningful difference” between the prior HANA GROUP and Design mark and Applicant’s pending HANA BANCORP and Design mark. Both marks begin with the term HANA and contain the same design element. HANA is the first and dominant portion of each mark. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark

¹² Applicant’s Brief, 13 TTABVUE 5.

which is most likely to be impressed upon the mind of a purchaser and remembered”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word). The term “Group” is disclaimed in the HANA GROUP and Design registration, and the term “Bancorp” is disclaimed in the HANA BANCORP and Design application. Disclaimed, descriptive matter – such as “Group” and “Bancorp” in each mark – has less significance. *Cf. Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.”) (cleaned up, citation omitted).

The Class 35 services in the prior HANA GROUP and Design registration and in the pending HANA BANCORP and Design application are identical or otherwise related. Although the HANA GROUP and Design registration and the cited HANA FINANCIAL and Design registration have only coexisted for 2-½ years, *In re Strategic Partners* does not dictate the prior registration must be five years old. Rather, “the duration of coexistence ... should be considered together with all the other relevant *DuPont* factors.” TBMP § 1207.01; *see also, In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *18 (TTAB 2019) (The USPTO’s issuance of prior registrations to Applicant for similar marks is a highly fact specific *DuPont* factor and it is under very specific circumstances that this factor may matter); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017) (3 year

co-existence of Applicant's prior registration and the cited registration a relevant consideration).

We find, under the circumstances of this case, where (1) a prior registration, for a mark with no material difference from Applicant's pending mark, existed in excess of five years for identical and related services; and (2) the younger prior registration, again for a mark with no material difference from Applicant's pending mark, existed in excess of two years for identical and related services, the thirteenth *DuPont* factor overcomes the other *DuPont* factors that otherwise might support a finding that confusion is likely.

IV. Likelihood of Confusion - Conclusion

We find the thirteenth *DuPont* factor, in view of the ownership of the HANA BANK and Design and HANA GROUP and Design registrations by Applicant's Hana Bank subsidiary (for Class 36 and 35 services, respectively), is dispositive in this case. We find this is so even though the first, second and third *DuPont* factors might otherwise weigh in favor of a finding that confusion is likely between the HANA BANCORP and Design and HANA FINANCIAL and Design marks and associated services.

Decision:

The refusal to register Applicant's  HANA BANCORP mark in Classes 35 and 36 on the ground of likelihood of confusion pursuant to Trademark Act Section 2(d) is reversed.